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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3689

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/821,371	Applicant(s) DIAZ ET AL.	
	Examiner Tan Dean D. Nguyen	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 19-28, 30-35, 37-40, 43-48, 50-55 and 75-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19-28, 30-35, 37-40, 43-48, 50-55 and 75-85 is/are rejected.
- 7) ☒ Claim(s) 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The "Notice of Allowability" on 05/28/03 has been vacated. The case is reopened due to other issues as shown below.

Reissue Applications

2. 1) This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission is an appropriate party to sign on behalf of the assignee. 37 CFR 3.73(b). The current office record on the US patent 5,890,128 indicates that "DIAGEN TECHNOLOGIES, INC." is the assignee.

A proper submission establishing ownership interest in the patent, pursuant to 37 CFR 1.172(a), is required in response to this action.

2) There is a formatting error to claim 4 in the latest amendment in the previous item (a). It appears that the term "from" is new or amended.

Claims Status

3. Claims 1-16, 19-28, 30-35, 37-40, 43-48, 50-55, and 75-85 are pending. Claims 17-18, 29, 36, 41-42, 49, 56-74 and 86 have been canceled.

4. They comprise 5 sets/groups of claims:

1) device¹: 1-14,

2) device²: 15,

Art Unit: 3689

3) device³ (new): 16, 19-28, 30-35, 37-39;

4) method¹: 40, 43-48 and 50-54, and

5) method²: 55, 75-85.

As of 2/7/07, independent device (apparatus) **claim 1** is as followed:

1. (Previously amended) An interactive personal nutrition and exercise management tool computing device comprising:

(a) a hand held computer case;

(b) a standard electronic computer circuit contained within said computer case, said circuit containing at least a random access memory, a read only memory, a processor and a coprocessor;

(c) a keyboard positioned on said computer case comprising a plurality of standard keyboard buttons including alphabetical characters, numerical characters, predetermined punctuation marks, predetermined mathematical functions, space function, and shift function;

(d) a plurality of standard computer function buttons positioned on said computer case comprising data enter means to store predetermined data in [predetermined] said random access memory, activation means of predetermined computer functions, a deletion means to remove predetermined data from said random access memory, a reset means to restore predetermined random access memory locations to predetermined values, a menu access means electrically connected to said processor for retrieval of nutrition and exercise menus, a scrolling means electrically connected to said processor to look up screen viewed data in four basic directions, and a quick exit

Art Unit: 3689

means electrically connected to said processor to initiate instant egress from computer system;

(e) a plurality of special function buttons positioned on said computer case comprising a retrieval means electrically connected to said processor to quickly access predetermined random access memory locations containing predetermined user personal data, weight, caloric consumption, fat consumption and caloric output data, and a toggle switch means electrically connected to said processor to start and stop predetermined exercise activity measurements;

(f) a liquid crystal display positioned on said computer case with viewing area adequate to present a plurality of graphs, charts, lists and information gathering screens stored in predetermined said random access memory locations;

(g) a receiving means in said computer case electrically connected to said processor to monitor/store signals from a plurality of exercise activity measurement transmitting devices.

I. Findings of Facts

1) case:

1 a : a box or receptacle for holding something **b** : a box together with its contents **c** : SET; *specifically* : PAIR

2 a : an outer covering or housing <a pastry *case*> **b** : a tube into which the components of a round of ammunition are loaded

3 : a divided tray for holding printing type

2) button:

Art Unit: 3689

1 a : a small knob or disk secured to an article (as of clothing) and used as a fastener by passing it through a buttonhole or loop **b** : a usually circular metal or plastic badge bearing a stamped design or printed slogan <campaign *button*>

2 : something that resembles a button: as **a** : any of various parts or growths of a plant or of an animal: as (1) : BUD (2) : an immature whole mushroom; *especially* : BUTTON MUSHROOM (3) : the terminal segment of a rattlesnake's rattle **b** : a small globule of metal remaining after fusion (as in assaying) **c** : a guard on the tip of a fencing foil

3 a : PUSH BUTTON **b** : something (as a push button) that has the real or symbolic capability of initiating a catastrophe (as a nuclear attack) <has his finger on the *button*>

d : a usually box-shaped computer icon that initiates a specific software function

3) list:

Main Entry: **list**

Function: *noun*

Etymology: French *liste*, from Italian *lista*, of Germanic origin; akin to Old High German *līsta* edge

Date: 1602

1 a : a simple series of words or numerals (as the names of persons or objects) <a guest *list*> **b** : an official roster : ROLL

2 : CATALOG, CHECKLIST

3 : the total number to be considered or included

See *Merriam-webster Online Dictionary*, available at <http://www.merriam-webster.com/dictionary/event> (visited on August 26, 2009).

II. Principles of Law

Art Unit: 3689

5. Claims 1-14, 15 and 16, 19-28, 30-35, 37-39 are apparatus claims.

Note: In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See (1) MPEP 2114. (2) *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Apparatus claims cover what a device is, not what a device does, i.e. "device which acts or performs ...". (3) *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990).

Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. (4) *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

1) Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "for managing" carries no patentable weight.

2) In claim 15, the last phrase in the claim, "whereby a person can view or enter... or athletic reasons", is considered as "manner of operating the device or elements of the device" and having no patentable weight in an apparatus claim.

6. Claims 55, 75-85 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period.

Current claim 55 does not contain the most critical step of claimed scope of "calculating a nutritional burn rate over said period of time from said personal data and said exercise activity selection (see the last step of independent method claim 40).

This step/limitation are shown in independent apparatus claim 1 and 15 and 16. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects. There is a citation of "to calculate said nutritional burn rate over said period of time" in claim dep. Claim 80. But this limitation is interpreted as "intended use" of the "used said exercise time". This is not a positive limitation as required in a method claim. Applicant needs to add the step of "calculating a nutritional burn rate over said period of time from said personal data and said exercise activity selection" in independent method claim 55.

Specification

7. The abstract of the disclosure is objected to because it contains more than 250 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

8. Claim 48 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 48 depends on independent claim 40. Claim 48 includes the limitation of “to calculate said nutritional burn rate over said period of time” which appears to be in the last step of independent claim 40 already, so it's not clear how claim 48 further limits claim 40?

III. Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 4-14 (apparatus), 15 (apparatus) 16, 19-28, 30-35, and 37-39 (apparatus), are rejected under 35 U.S.C. 101 because the claimed invention is directed to more than one class of statutory subject matter.

1) The independent **claim 1** begin by discussing “an interactive personal nutrition and exercise management tool computing device (or apparatus)”, but dependent claim 4 contain method steps, i.e.:

(a) “output which are derived using”,

(b) “...that utilizes an activity..”,

(c) “... said coprocessor uses said...”

(d) "...data is used to derive ...",

(e) "... intake nears or exceeds the target calorie and fat values.",

that are normally used in a method claim. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

2) Similarly, dependent claim 5 has the same problems above:

"...is used to derive..", and "...has elapsed..".

3) Similarly, dependent claim 7 has the same problems above:

"...a menu driven means accesses a main menu..", and "...has elapsed..".

4) Similarly, dependent claim 13 has the same problems above:

"...password matches a personal identification number entered by the user...".

5) Similarly, dependent claim 14 has the same problems above:

"...alarm settings match actual dates and times".

6) The independent **claim 15** begin by discussing "In a hand held computer", but the body of the claims use method steps, i.e. (a) "are used to set", "to enter", (b) "retrieve", (d) "using ... to accrue", (f) "... matches the alarm date ..", (g) "... to convert ..", and "whereby a person can view or enter...", "automatically inputted "activity calorie burning data tracked and viewed..", "... of controlling body weight..", that are normally

Art Unit: 3689

used in a method claim. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

7) The independent **claim 16** begin by discussing "'an interactive personal nutrition and exercise management tool computing device", but the body of the claims use method steps, i.e. (d) "such that said user can select ...", "can select...", "by navigating ...", "can select..", "by navigating...", that are normally used in a method claim. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

8) Similarly, dependent claim 19 has the same problems above:

"...user can enter personal data ...".

9) Similarly, dependent claims 25-28, 30 have the same problems above:

"...user can input ...", "can input..."

10) Similarly, dependent claim 38 has the same problems above:

"...user can program ...", "alarm goes off...", and "accumulation approaches...".

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 3689

12. **Claims 40, 43-48, 50-54 (method), 55, 75-85 (method)** are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must

(1) be tied to a particular machine or apparatus or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing.

See (1) *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); (2) *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); (3) *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); and (4) *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. See claim 1 or 7 of *Diehr, II, et al.*, US patent 4,344,142.

Here, applicant's method steps fail the **first** prong of the new test because the claimed invention fails to set forth a particular machine that is specifically configured/programmed to carry out the claimed invention, especially the critical step "calculating a nutritional burn rate over said period of time from said personal data and said exercise activity selection (independent method claim 40, last step). The various steps in claim 40 such as "storing, receiving, retrieving, etc." are considered as insignificant extra-solution activity. Specifically, the Examiner asserts that the current claim language can be interpreted that the user, is performing the claimed invention.

Similarly, as for independent method claim 55, they basically comprise a series of insignificant steps such as data gathering, retrieving, and storing. Dependent claim 80 discloses the limitation of "...to calculate said nutritional burn rate over said period of time", but this is considered as "intended use" of the "used said exercise time". This is a method claim and only phrase such as "calculating said nutritional burn rate over said period of time" receives patentable weight.

Further, applicant's method steps fail the **second** prong of the test because there is no transformation of the data. It is asserted that the data has not been transformed into another state or into another object.

The applicant is reminded that:

"Purported transformation or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances.

(In re Bernard L. Bilski and Rand A. Warsaw Page 28)"

Moreover, the "transformation must be central to the purpose of the claimed process.

(In re Bernard L. Bilski and Rand A. Warsaw Page 28)"

13. Note that the recitations "... with an interactive personal nutrition and exercise management too" in the preamble is noted, however, this has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 112

14. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: there is a citation of "a processor" and "a coprocessor" in element (b) and the relationship of "the

Art Unit: 3689

processor” to the rest of the claim elements (d), (e) and (g). There is no discussion of the relationship of the “co-processor” to the rest of the claim elements.

2) In claim 1, the phrase “a plurality of standard computer function buttons positioned on said computer case comprising data enter means (function) to store predetermined data in said random access memory” is vague because “standard computer button” is merely a device, i.e. knob or key or keyboard or a element/device positioned on the computer case. Unless the computer is on, operating and running in a specific application properly, it's not clear how the buttons positioned on said computer case comprising all of the functions/steps such as “data enter means to store predetermined data in said random access memory” when the computer is not on or running / operating on a specific mode. Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed / used / functioned (i.e. computer is running or operating on a specific personal nutrition and exercise applications), does not differentiate apparatus from the prior art apparatus.

3)) In claim 1, the phrase “a plurality of special function buttons positioned on said computer case comprising a retrieval means electronically connected to said processor to quickly access...” is vague because “computer button” is merely a device, i.e. knob or key or keyboard or a element/device positioned on the computer case. Unless the computer is operating and running properly, it's not clear how the buttons positioned on said computer case comprising all of the functions/steps such as “a

Art Unit: 3689

retrieval means electronically connected to said processor to quickly access” when the computer is not on or running or operating on a specific mode.

4) In claim 1, element (d), last line, the phrase “from computer system” is vague because it’s not clear what the “computer system” it refers to? There is a “computing device” in the preamble but not “computer system”?

(5) In claim 1, element (g), the phrase “receiving means in said computer case electrically connected to said processor to monitor/store signals” is vague because “receiving” step normally involves “accepting” or “inputting” signal or data. It's not clear how a "receiving" step/mean can include "monitor/manage" and "store" signal or data?

6) In claim 8, from the definition of a “list” indicated above, i.e. “checklist” or “a simple series of words or numerals”, it’s not clear how a “food list” can contain items “(b) a food selection means” and (c) the coprocessor and random access memory are configured to accumulate ...”.

7) Similarly in claim 9, from the definition of a “list” indicated above, i.e. “checklist” or “a simple series of words or numerals”, it’s not clear how a “food list” can contain items “(b) an exercise selection means” and (c) a plurality of exercise input means”.

15. Claims 1-14 (apparatus), and 15 (apparatus) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant asserts that the claim elements:

1) In independent claim 1:

Art Unit: 3689

(1) "data enter means to store", (2) "activation means", (3) "a deletion means to remove predetermined data", (4) a reset means to restore...", (5) "a menu access means ... for retrieval of ..."; (6) a scrolling means ...to look up screen viewed data", (7) "a quick exit means ... to initiate", (8) "a retrieval means ... to quickly access", (9) "a toggle switch means ..to start and stop..", (10) " a receiving means .. to monitor/store signals ...".

2) In dependent claim 2:

(1) "a wireless communication means ... to transfer exercise activity data..".

3) In dependent claim 4:

(1) "the plurality of exercise input means", (2) "caloric output conversion means", and (3) "a comparison means";

4) In dependent claim 7:

(1) "a menu driven means accesses ...",

5) In dependent claim 8:

(1) "a food selection means ... to retrieve...",

6) In dependent claim 9:

(1) "an exercise selection means connected to said processor for retrieval of selected exercise activity with respective calorie burning rate",

(2) "a plurality of exercise input means ", "receiving means," , "an internal timer means" and "a manual means".

7) In dependent claim 13:

(1) “a comparison means to allow ...”,

8) In dependent claim 14:

(1) “a comparison and sound generation means electrically connected to a plurality of alarm input screens, said random access memory, the data and time clock, and said keyboard to provide determined audible signals and screen messages when predetermined alarm setting match actual dates and times”,

9) In independent claim 15:

(1) (a) “menu driven means”,

(2) “(c) a plurality of calculation means for producing personalized results ... “;

(3) “(d) an accumulation means using the coprocessor and said random access memory to accrue ...”,

(4) “(e) a status retrieval means for selecting and viewing a plurality of current or historical data ...”

(5) “(f) an alarm means for providing ...”

(6) (g) a wireless receiving means within said hand held computer electrically connected to said central processing unit in such a manner as to convert incoming signals ...”

(7) “an exercise activity measurement sensor means electrically connected to ...”,

(8) “... a wireless transmission means into calories burned in the course of a plurality of activities”;

, is/are a **means (or step) plus function** limitation that invokes 35 U.S.C. 112, sixth paragraph. However, it is unclear whether the claim element is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph, because the proper format of “means for ...” is not shown in all of the claims and language such as “data enter means to store ... data” has been interpreted as “means plus function” language before in many cases as having similar language to the “means plus function” claim.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to:

(a) Amend the claim to include the phrase “means for” or “step for” in accordance with these guidelines: the phrase “means for” or “step for” must be modified by functional language and the phrase must **not** be modified by sufficient structure, material, or acts for performing the claimed function; or

(b) Show that the claim limitation is written as a function to be performed and the claim does **not** recite sufficient structure, material, or acts for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph. For more information, see MPEP § 2181.

16. Claim elements, as cited above, are means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.

Art Unit: 3689

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function.

For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

3) In independent system claim 1, the phrase "to monitor/store signals" is vague because it's not clear what the "/" really means? Does it mean "or" or "and" or "and/or" or combination of both? These two action verbs "monitor" and "store" have distinct meanings and can not be used as being equivalent.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. **Claims 1-13 (system), 55, 75-85 (method) and 40, 43-48 and 50-54 (method) are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) WILLIAMS, III in view of (2) ANDRUS et al.**

As for independent system claim 1, which deals with an interactive personal nutrition and exercise management tool computing device, WILLIAMS, III discloses a device comprising:

(a) a hand held computer case;

{see Fig. 1, claim 1 "**A hand held nutritional microcomputer apparatus..**"}

(b) a standard electronic computer circuit contained within said computer case, said circuit containing at least a random access memory, a read only memory, a processor and a coprocessor;

{see Fig. 1, cols. 5-6}

(c) a keyboard positioned on said computer case comprising a plurality of standard keyboard buttons including alphabetical characters, numerical characters, predetermined punctuation marks, predetermined mathematical functions, space function, and shift function;

{see Fig. 1, element 11}

(d) a plurality of standard computer function buttons positioned on said computer case comprising data enter means to store predetermined data in [predetermined] said random access memory, activation means of predetermined computer functions, a deletion means to remove predetermined data from said random access memory, a reset means to restore predetermined random access memory locations to predetermined values, a menu access means electrically connected to said processor for retrieval of nutrition and exercise menus, a scrolling means electrically connected to said processor to look up screen viewed data in four basic directions, and a quick exit means electrically connected to said processor to initiate instant egress from computer system;

{see Fig. 1, elements 11, 15, 18, cols. 11-12}

(e) a plurality of special function buttons positioned on said computer case comprising a retrieval means electrically connected to said processor to quickly access predetermined random access memory locations containing predetermined user personal data, weight, caloric consumption, fat consumption and caloric output data, and a toggle switch means electrically connected to said processor to start and stop predetermined exercise activity measurements;

{see Fig. 1, element 15, element 18, Figs. 2, 3, 5, 6, 17, 24, 25, 26, 27, 28}

(f) a liquid crystal display positioned on said computer case with viewing area adequate to present a plurality of graphs, charts, lists and information gathering screens stored in predetermined said random access memory locations;

{see Fig. 1, element 12, 16, Figs. 6, 22, 23, 26, 27, 28}

WILLIAMS, III fairly teaches the claimed invention except for the last element (g) of (g) a receiving means in said computer case electrically connected to said processor to monitor/store signals from a plurality of exercise activity measurement transmitting devices. Note that this statement (summarization) is agreed upon/supported by applicant's response on page 16, 3rd paragraph, of May 6, 2002.

In a similar interactive applications including personal activity (entertainment) and exercise activity application using a management tool computing device, **ANDRUS et al** is cited to teaches the system to carry out the interactive applications including standard communication equipments and computer system including the last element (g) of a receiving means in said computer case electrically connected to said processor to monitor/store signals from a plurality of exercise activity measurement transmitting devices (exercise machine) for receiving data packet including data bytes indicating the status of the exercise machine and certain predetermined exercise actual conditions such as, for example, heart rate, pedal rpm, calorie consumption (burn rate) and other similar conditions for use in the management of the interactive applications to improve exercise results {see Fig. 4, element 26, Fig. 5, Fig. 6, elements 94, 102, 204, 108, 120, cols. 3-4, 21-22}. Therefore, it would have been obvious to a person having ordinary skill in the art (herein after as "PHOSITA") at the time of the invention was made to modify the system of WILLIAMS, III to include element (g) as taught by WILLIAMS, III, for interactive management of two applications as desired and for improving the exercise results due to actual information/conditions.

Note that In **KSR**, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “*the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” See KSR, 550 US at 406. Id. at 416.*

In this case the combination of a method of facilitating two related interactive applications (entertainment and exercise) management disclosed by ANDRUS et al and interactive applications (nutritional and exercise) management disclosed by WILLIAMS, III, would yield a predictable result, specifically a method of management of two interactive related applications. It would have been obvious to one of ordinary skill in the art to modify WILLIAMS, III’ system to include data signal receiving means of ANDRUS et al because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

As for dep. claim 2 (dep. on claim 1), which deal with the features of the exercise activity measurement transmitting devices, externally located and are connected by a wireless communication devices, these are inherently included in the teaching of WILLIAMS, III /ANDRUS et al as shown in ANDRUS et al Figs. 1, 4, 6 and col. 10, lines

Art Unit: 3689

45-52 “...Alternatively, data could be communicated via light, radio or other suitable media...” which reads over “wireless”. Alternatively, in view of the teaching of “suitable media”, the use of other wireless communication types or “suitable media” such as wireless data would have been obvious to a skilled artisan as merely using other “suitable media”.

As for dep. claims 3-4 (dep. on claim 1), which deal with the various well known features of the nutritional and exercise management parameters, i.e. determining or calculating suggested weight or goal for the weight, diet goal, calories burned rate, etc., these are fairly taught in WILLIAMS, III Figs. 2, 6, 24, 25, 28, 34-36, cols. 5-9 and ANDRUS et al cols. 9-10, activity measurement transmitting devices, externally located and are connected by a wireless communication devices, these are inherently included in the teaching of WILLIAMS, III /ANDRUS et al as shown in ANDRUS et al Figs. 1, 4, 5, 6, 14 and col. 10, lines 45-52.

As for dep. claims 5-6 (dep. on claim 1), which deal with the various well known calculated target features of the nutritional and exercise management parameters, i.e. determining or calculating total caloric intake, total fat intake, suggested weight or goal for the weight, diet goal, calories burned rate, etc., these are fairly taught in WILLIAMS, III Figs. 2, 6, 24, 25, 28, 34-36, cols. 5-9 and ANDRUS et al cols. 9-10 and Figs. 5, 14.

As for dep. claims 7-9 (dep. on claim 1), which deal with the various well known menu functions parameters, accessing menu or exercise lists, options, functions, etc., these are fairly taught in WILLIAMS, III Figs. 2, 6, 8, 16, 24, 25, 28, 34-36, cols. 5-9 and ANDRUS et al cols. 9-10, Figs. 5, 14.

As for dep. claims 10-12 (dep. on claim 7/1), which deal with the various subsystems for managing nutrition and exercise parameters, i.e. total calorie intake daily, time profile such as date and time and personal profiles, etc., these are fairly taught in WILLIAMS, III as shown on Figs. 2, 6, 24, 25, 28, 34-36, cols. 5-9 and ANDRUS et al cols. 9-10 and Figs. 5, 11-12 and 14.

As for dep. claim 13 (dep. on claim 7/1), which deal with well known user computer access management parameters, i.e. using/managing password and comparing user entered password to previous user identification data, it would have been obvious to carry out this step if accessing to the computer device is not open to everyone or only selected user is permitted.

As for independent method¹ claim 55, it's basically the method of to carry out the limitation of independent system claims 1 and 2, therefore, it's rejected for the same reason set forth in the rejections of claims 1 and 2 above.

As for dep. claim 75 (dep. on claim 55), which deal with well known personal data parameters and nutrition data parameters, i.e. user's height or weight, etc., these are taught in WILLIAMS, III Figs. 3-6.

As for dep. claims 76-79 (dep. on claim 55), which deal with well known data input, i.e. user can enter data about self, nutrition and exercise, these are taught in WILLIAMS, III Figs. 3-4, 17-19, 22-23, 28 and 34-35 and ANDRUS et al Fig. 5.

As for dep. claim 80 (dep. on claim 55), which deal with well known monitoring calorie consumption, i.e. calculating nutrition burned during certain time period, this is

Art Unit: 3689

taught in WILLIAMS, III / ANDRUS et al as shown in WILLIAMS, III Fig. 28 and ANDRUS et al Fig. 5.

As for dep. claim 81 (dep. on claim 55), which deal with well known monitoring calorie consumption, i.e. adjusting nutrition burned rate due to exercising information, this is taught in WILLIAMS, III / ANDRUS et al as shown in WILLIAMS, III Figs. 26-29 and ANDRUS et al Fig. 5.

As for dep. claims 82-85 (dep. on claim 55), which deal with well known displaying parameters, i.e. nutrition information and burning rate in various formats, a graph or tabular format, etc., these are taught in WILLIAMS, III / ANDRUS et al as shown in WILLIAMS, III Figs. 22-25, 27, 29 and ANDRUS et al Figs. 7 and 14.

As for independent method² claim 40, which has the same limitation as in method claims 55 and 80, therefore, it's rejected for the same reason set forth in the rejections of claims 55 and 80 above.

As for dep. claims 43-48 and 50-54 (dep. on claim 40), which basically have the same limitation as in dep. claims 75-85 respectively (dep. of claim 55) above, they are rejected for the same reason set forth in the rejections of claims 75-85 above.

20. Claims 14, 15 (computer), 16, 19-28, 30-35 and 39 (a computing device) are rejected under 35 U.S.C. 103(a) as being unpatentable over WILLIAMS, III / ANDRUS et al as applied to claims 1-13 above, and further in view of SUGARMAN et al.

Art Unit: 3689

As for dep. claim 14, in a similar interactive applications including personal activity (dietary fat control) using a management tool computing device, **SUGARMAN et al** is cited to teaches the system to carry out the interactive applications including standard communication equipments and computer system including the last element (h) of “an **alarm** system” comprising a comparison and sound generation means upon meeting an alarm condition, i.e. date and time or other, this is fairly taught in Fig. 1, element 127, Fig. 2, 4, 6B, Fig. 7, element 307, 321, 323, 329, 325, 327, 329 and 331, cols. 7, lines 30-40, col. 8, lines 35-55, col. 9, lines 20-45, “**ALERT**”, “**AVOID**”, “**ALARM**”, claim 1, etc., to alert/warn the user of “abnormal or alert or “AVOID” condition in comparing with a predetermined condition.

Therefore, it would have been obvious to a person having ordinary skill in the art (herein after as “PHOSITA”) at the time of the invention was made to modify the system of WILLIAMS, III /ANDRUS et al to include “alarm” system comprising a comparison and sound generation means upon meeting an alarm condition, i.e. date and time or other, this is fairly taught by SUGARMAN et al in Fig. 1, element 127, Fig. 2, 4, 6B, Fig. 7, element 307, 321, 323, 329, 325, 327, 329 and 331, cols. 7, lines 30-40, col. 8, lines 35-55, col. 9, lines 20-45, “**ALERT**”, “**AVOID**”, “**ALARM**”, claim 1, etc., to alert/warn the user of “abnormal or alert or “AVOID” condition in comparing with a predetermined condition.

As for independent apparatus claim 15, which basically have the same limitation or combination of claims 1, 2 (wireless feature) and 14 (alarm feature) above, it's rejected for the same reason set forth in the rejections of claims 2 and 14.

As for independent apparatus claim 16, which basically have the same limitation or combination of claims 1, 2 (wireless feature) above, it's rejected for the same reason set forth in the rejections of claims 1 and 2.

As for dep. claims 19, 25-26, 30 (dep. on claim 16), which deal with well known data input, i.e. user can enter data about self, nutrition and exercise, these are taught in WILLIAMS, III Figs. 3-4, 17-19, 22-23, 28 and 34-35 and ANDRUS et al Fig. 5.

As for dep. claim 20 (dep. on claim 16), which deal with well known monitoring calorie consumption, i.e. calculating nutrition burned during certain time period, this is taught in WILLIAMS, III / ANDRUS et al as shown in WILLIAMS, III Fig. 28 and ANDRUS et al Fig. 5.

As for dep. claims 21-24 (dep. on claim 16), which deal with well known personal data parameters and nutrition data parameters, i.e. user's height or weight, etc., these are taught in WILLIAMS, III Figs. 3-6.

As for dep. claims 27-28 (dep. on claim 16), which deal with well known burn rate calculation parameters, i.e. using a timer (clock) to determine an exercise time and a toggle switch so that a user can start or stop the timer, these are taught in WILLIAMS, III /ANDRUS et al as shown in WILLIAMS, III Fig. 5 8 "SWITCH", and Fig. 11.

As for dep. claims 31-32 (dep. on claim 16), which deal with well known burn rate calculation parameters, i.e. calculating calories burned during a time period, these are taught in WILLIAMS, III Figs. 3-4, 17-19, 22-23, 28 and 34-35 and ANDRUS et al Fig. 5.

As for dep. claims 33-35 (dep. on claim 16), which deal with well known displaying parameters, i.e. nutrition information in various formats, a graph or tabular format, etc., these are taught in WILLIAMS, III / ANDRUS et al as shown in WILLIAMS, III Figs. 22-25, 27, 29 and ANDRUS et al Figs. 7 and 14.

As for dep. claim 39 (dep. on claim 16), which deal with well known personal/exercise data parameters, i.e. calorie burning rate for various exercise activities, etc., these are taught in WILLIAMS, III Figs. 27, 28, and ANDRUS et al Fig. 5, 11, and 14.

21. Dependent claims 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over WILLIAMS, III / ANDRUS et al as applied to claims 16-28, 30-35, 39 above, and further in view of SUGARMAN et al.

As for dep. claim 37, in a similar interactive applications including personal activity (dietary fat control) using a management tool computing device, **SUGARMAN et al** is cited to teaches the system to carry out the interactive applications including standard communication equipments and computer system including the last element (h) of “an **alarm** system” comprising a comparison and sound generation means upon meeting an alarm condition, i.e. date and time or other, this is fairly taught in Fig. 1, element 127, Fig. 2, 4, 6B, Fig. 7, element 307, 321, 323, 329, 325, 327, 329 and 331,

Art Unit: 3689

cols. 7, lines 30-40, col. 8, lines 35-55, col. 9, lines 20-45, **“ALERT”**, **“AVOID”**, **“ALARM”**, claim 1, etc., to alert/warn the user of “abnormal or alert or “AVOID” condition in comparing with a predetermined condition.

Therefore, it would have been obvious to a person having ordinary skill in the art (herein after as “PHOSITA”) at the time of the invention was made to modify the system of WILLIAMS, III /ANDRUS et al to include “alarm” system comprising a comparison and sound generation means upon meeting an alarm condition, i.e. date and time or other, this is fairly taught by SUGARMAN et al in Fig. 1, element 127, Fig. 2, 4, 6B, Fig. 7, element 307, 321, 323, 329, 325, 327, 329 and 331, cols. 7, lines 30-40, col. 8, lines 35-55, col. 9, lines 20-45, **“ALERT”**, **“AVOID”**, **“ALARM”**, claim 1, etc., to alert/warn the user of “abnormal or alert or “AVOID” condition in comparing with a predetermined condition.

As for dep. claim 38 (dep. on claim 16), which deal with well known monitoring parameters, i.e. alarm features etc., these are taught in WILLIAMS, III / ANDRUS et al as shown in WILLIAMS, III Figs. 22-25, 27, 29 and ANDRUS et al Figs. 7 and 14.

Art Unit: 3689

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23. In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

24. Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805. The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/

Primary Examiner, Art Unit 3689

8/31/09